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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,444	03/12/2004	Dwight Allen Merriman	16113-1341008	5265
26192 7590 02/13/2009 FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022				
EXAMINER GOLDMAN, MICHAEL H				
ART UNIT 3688		PAPER NUMBER		
NOTIFICATION DATE 02/13/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary

Application No.

10/798,444

Applicant(s)

MERRIMAN ET AL.

Examiner

MICHAEL H. GOLDMAN

Art Unit

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a Non Final Office Action in response to communications received November 11, 2008. Claims 7-14 have been added. Therefore, claims 1-14 are pending and addressed below.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 7 and its dependent claims are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to a particular machine (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. . Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing.

Also see, United State Court of Appeals for the Federal Circuit, 2007-1130,
(Serial No. 08/833,892)
IN RE BERNARD L. BILSKI
and RAND A. WARSAW.

For example in claim 7, the steps of “receiving a plurality of advertisement requests...”, “collecting information based on the advertisement requests...”, and “selecting, in response to an advertisement request,...”, etc. should individually incorporate a particular machine (computer, apparatus or hardware per se); otherwise it can be concluded, under a broad interpretation, that those steps were manually performed. Here, to be statutory, under USC 101, each individual step should incorporate or should be performed using a particular machine (computer, apparatus or hardware per se).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 7-8 and 10-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Goldhaber et al., (5,794,210).

Claim 7: Goldhaber discloses a method comprising:

a. receiving a plurality of advertisement requests from a user node, each advertisement request based upon a link from an affiliate node to the user node in response to a content request sent from the user node to the affiliate node (see Fig 11, whereby user receives content requested (at user node), e.g. content items 62(1-3) Ski..., Metro Opera... and ...Flute Simulcast, and item 63 is a link (from affiliate), coupon for Nonfat Cheesecake; also see column 5, line 3

whereby (a plurality of) ads are targeted to user node);

b. collecting information based upon the advertisement requests (see Fig 12 item 200 whereby Goldhaber user interacts with ad (via link/activates CyberCoin), and collects interaction data (information based upon the advertisement requests, and see item 232 whereby Goldhaber inactivates CyberCoin once success with given CyberCoin achieved, thereby keeping track of ads viewed via CyberCoin link);

c. selecting an advertisement in response to an advertisement request, an advertisement based upon the collected information (column 14, lines 17-40, also see Fig 12, item 232 whereby ads/CyberCoin links are not repeated due to inactivation);

d. updating the available advertisements (Fig 11A, items 194 and 186 whereby server scans for matching ads and then scans for used ads resulting in available ads to place in users node, item 196).

f. sending the selected advertisement to the user node for display (Fig 11A,, item 196 and column 16, lines 6-10 and column 18, lines 27-33).

Claim 10 and 14: Goldhaber discloses a method for advertising as in Claim 1 and 7 above, and further discloses performing a reverse domain name lookup based upon the advertisement request (column 12, lines 14-37 and column 17, lines 1-3).

Claim 11: Goldhaber discloses a method for advertising as in Claim 2 and 7 above, and further discloses receiving a click-through request for information about the advertiser associated with the advertisement (column 11, lines 16-24 and column 16, lines 6-10).

Claim 12: Goldhaber discloses a method for advertising as in Claim 3 and 11 above, and further discloses sending a network address (URL) to the user in response to the click- through request (column 16, lines 57-64).

Claim 13: Goldhaber discloses a method for advertising as in Claim 3 and 7 above, and further discloses storing information about a prior click-through from said user (column 7, lines 8-19; column 12, lines 14-37; and column 18, lines 1-2).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al. (5,794,210).

Claim 1, and 9: Goldhaber discloses an apparatus for advertising, comprising:

- a. a processor, memory, and database (column 9, line 33 - column 10, line 8);
- b. collecting information based upon a plurality of advertisement requests sent from a user (column 12, lines 14-37, also see Fig 12 item 200 whereby Goldhaber user interacts with ad (via link/activates CyberCoin), and collects interaction data (information based upon the advertisement requests, and see item 232 whereby Goldhaber inactivates CyberCoin once success with given CyberCoin achieved, thereby keeping track of ads viewed via CyberCoin link);
- c. selecting an advertisement based upon the collected information (column 14, lines 17-40, also see Fig 12, item 232 whereby 'CyberCoin links'(ads) are not repeated due to inactivation);
- d. basing the advertisement request on a link on a content request from said user (column 7, lines 28-46 and column 16, lines 6-10); and
- e. updating the available advertisements (column 14, lines 23-31, Fig 11A, items 194 and 186 whereby server scans for matching ads and then scans for used ads resulting in available ads to place in users node, item 196);
- f. sending the selected advertisement to the user node for display (Fig 11A,, item 196 and column 16, lines 6-10 and column 18, lines 27-33).

While Goldhaber does not explicitly disclose generating a report about the placement of advertisements, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide reports about advertisement placement back to the advertisers. One would have been motivated to provide such reports in view of Goldhaber's disclosure that the problem his invention overcomes is "how will advertisers know that they are getting their money's worth?" (column 5, lines 56-57). Goldhaber further discloses billing the advertiser for the number of "cyber-coins" clicked on by the users. This also implies that the advertiser is receiving a report in order to ascertain both the amount to pay and the basis for the bill.

Claim 2: Goldhaber discloses an apparatus for advertising as in Claim 1 above, and further discloses sending the selected advertisement to the said user for display (column 16, lines 6-10 and column 18, lines 27-33).

Claim 3: Goldhaber discloses an apparatus for advertising as in Claim 2 and 7 above, and further discloses receiving a click-through request for information about the advertiser associated with the advertisement (column 11, lines 16-24 and column 16, lines 6-10).

Claim 4: Goldhaber discloses an apparatus for advertising as in Claim 3 and 11 above, and further discloses sending a network address (URL) to the user in response to the click- through request (column 16, lines 57-64).

Claim 5: Goldhaber discloses an apparatus for advertising as in Claim 3 and 7 above, and further discloses storing information about a prior click-through from said user (column 7, lines 8-19; column 12, lines 14-37; and column 18, lines 1-2).

Claim 6: Goldhaber discloses an apparatus for advertising as in Claim 1 and 7 above, and further discloses performing a reverse domain name lookup based upon the advertisement request (column 12, lines 14-37 and column 17, lines 1-3).

Response to Arguments

4. Applicant's arguments filed May 2, 2008 have been fully considered but they are not persuasive.

Applicant argues "...cited art neither teaches nor suggest the features described...For example, the cited portions of Goldhaber does not suggest or teach an advertisement request based upon a link sent from an affiliate node to a user Node in response to a content request sent from the user node to the affiliate node... This system delivers advertisements directly to consumers--there is no role for an affiliate node in the system"

Examiner, respectfully disagrees. Goldhaber provides an example in column 7, line 28 whereby 'Upon logging on to her (user) customized home page.' Examiner interprets the act of the user 'logging onto' as a content request sent from the user node to an affiliate node. In column 7, lines 28-30 'Cynthia (the user node) would be presented with a list of ads that she (the user) may elect (via link(s) sent from an affiliate node to a user node); the examiner interprets the

user *election* as an *advertisement request*, via the link(s) sent from an affiliate node, which were in response to a content request(s) sent from the user node to the affiliate node.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL H. GOLDMAN whose telephone number is (571)270-5101. The examiner can normally be reached on Monday thru Thursday 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Myhre can be reached on 571-272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Jean Janvier/

Primary Examiner, Art Unit 3688